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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/606,977 | 06/28/2000 | Joseph R. Byrum | 16517.144/38-21(15877)B | 6609 |

7590 05/23/2002

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EXAMINER

ALLEN, MARIANNE P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1631

DATE MAILED: 05/23/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,977

Applicant(s)

BYRUM, JOSEPH R.

Examiner

Marianne Allen

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Claims 1-19 are pending in the application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to polynucleotides, classified in at least for example, Class 536, subclass 23.1.
- II. Claims 8-10, drawn to a polynucleotide with two defined ends, classified in at least for example, Class 536, subclass 23.1.
- III. Claim 11-15, drawn to a transgenic plant, classified in at least for example Class 435, subclass 410.
- IV. Claim 16-19, drawn to a method of screening for a trait, classified in at least for example Class 435, subclass 6.

Sequence Election Requirement Applicable to All Groups

In addition, each Group detailed above reads on patentably distinct SEQ ID Numbers.

Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For Groups I, III, and IV, applicant must further elect a single SEQ ID Number for examination. Applicant must elect a particular pair of SEQ ID Numbers for Group II. The elected pair will be examined as a combination as set forth in MPEP 803.04.

MPEP 803.04 states that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an

Art Unit: 1631

independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141et seq.

Applicant is advised that examination will be restricted to only the elected SEQ ID NOS.

The inventions are distinct, each from the other for the following reasons.

Each of the products of groups I-III can be shown to be distinct, each from the other, because each product is structurally and functionally different. They do not require each other for their ultimate use. Each of the products can be shown to be distinct from the method of Group IV as the product is either not used in the method or it has additional uses. For example, the polynucleotides can be used to make proteins or for amplification. Each product and method would require a non-coextensive literature search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification as well as the necessity for a non-coextensive literature search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 7:00 am - 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Application/Control Number: 09/606,977

Page 3

Art Unit: 1631

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Marianne P. Allen
Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa

May 21, 2002